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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,959	12/14/2004	Eric Fresnel	6758-0005WOUS	3762
7590 01/23/2007 Marina F Cunningham McCormick Paulding & Huber CityPlace II 185 Asylum Street Hartford, CT 06103-3402			EXAMINER AUGHENBAUGH, WALTER	
			ART UNIT 1772	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/517,959

Applicant(s)

FRESNEL, ERIC

Examiner

Walter B. Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claims 1, 2 and 4-12 in the Amendment filed November 8, 2006 (Amdt. A) have been received and considered by Examiner.
2. New claims 22-25 presented in Amdt. A have been received and considered by Examiner.
3. Applicant's cancellation of claims 3 and 13-21 in Amdt. A has been acknowledged by Examiner.
4. The replacement abstract presented in Amdt. A has been received and considered by Examiner.

WITHDRAWN OBJECTIONS

5. The objection to the abstract made of record in paragraph 2 of the previous Office Action mailed August 8, 2006 has been withdrawn due to Applicant's amendments in the abstract in Amdt. A.

WITHDRAWN REJECTIONS

6. The 35 U.S.C. 112 rejection of claim 3 made of record in paragraph 4 of the previous Office Action mailed August 8, 2006 has been withdrawn due to Applicant's cancellation of claim 3 in Amdt. A.
7. The 35 U.S.C. 112 rejection of claims 5-9 and 12 made of record in paragraph 4 of the previous Office Action mailed August 8, 2006 has been withdrawn due to Applicant's amendments in claims 5-9 and 12 in Amdt. A.

REPEATED REJECTIONS

Claim Rejections - 35 USC § 112

8. The 35 U.S.C. 112 rejection of claims 2, 4, 10 and 11 made of record in paragraph 4 of the previous Office Action mailed August 8, 2006 has been repeated for the reasons previously made of record, although the basis for rejection of claim 2 regarding the “in its formulation” recitation has been withdrawn due to Applicant’s amendments in claim 2 in Amdt. A, and the basis for rejection of claim 4 regarding the “embossed zones... ratio” recitation has been withdrawn due to Applicant’s amendments in claim 4 in Amdt. A.

Claim Rejections - 35 USC § 102

9. The 35 U.S.C. 102 rejection of claims 1, 2 and 4-12 made of record in paragraph 6 of the previous Office Action mailed August 8, 2006 has been repeated for the reasons previously made of record, and for the following reasons that address the amendments in claims 1, 2, 4-9, 11 and 12 in Amdt. A: in regard to claim 1, Inagaki teaches that a technical agent (bonding agent) is coated on the inside or outer face of the sleeve (col. 2, lines 55-61) where the wall of the sleeve is embossed with a predetermined pattern so that the embossed pattern appears in relief on the outside face or inside face of the sleeve (col. 1, lines 11-12, col. 1, line 66-col. 2, line 2, col. 3, lines 27-30 and 38-50 and col. 4, lines 26-41). Inagaki teaches that the technical agent (bonding agent) is coated on the inside or outer face of the sleeve at the location of the embossed pattern (so, in and/or around the embossed pattern as claimed, col. 2, lines 55-61). The recitation “said technical agent being positioned to ensure that said embossed pattern remains after said sleeve has been shrunk onto the article(s) to be packaged” has not been given patentable weight since this recitation does not describe the structure of the final product that is claimed (the wrapper).

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Nonetheless, since the technical agent (bonding agent) is coated on the inside or outer face of the sleeve (col. 2, lines 55-61) where the wall of the sleeve is embossed with a predetermined pattern so that the embossed pattern appears in relief on the outside face or inside face of the sleeve (col. 1, lines 11-12, col. 1, line 66-col. 2, line 2, col. 3, lines 27-30 and 38-50 and col. 4, lines 26-41) and since the technical agent (bonding agent) is coated on the inside or outer face of the sleeve at the location of the embossed pattern (col. 2, lines 55-61), the technical agent is positioned to ensure that said embossed pattern exists in the final product (col. 1, lines 11-12, col. 1, line 66-col. 2, line 2, col. 3, lines 27-30, 38-50 and 55-61 and col. 4, lines 26-41).

In regard to claim 2, the recitation “the formulation of the semi-rigid film including an elastomeric phase” has not been given patentable weight since the language of claims 1 and 2 indicates that the film includes an elastomeric phase during the formation of the sleeve (“said sleeve being made from a film”, line 4 of claim 1), and does not require that the wrapper comprises an elastomeric phase in its final form.

In regard to claim 4, Inagaki teaches that the technical agent (bonding agent) is coated on the inside or outer face of the sleeve at the location of the embossed pattern (col. 1, lines 11-12, col. 1, line 66-col. 2, line 2, col. 3, lines 27-30, 38-50 and 55-61 and col. 4, lines 26-41). The recitation of claim 4 “in at least one zone that is associated with a shrinkage ratio exceeding about 10% to 15% during shrinking of said sleeve” cannot be given patentable weight since this recitation does not describe the structure of the final product that is claimed (the wrapper).

In regard to claim 5, Inagaki teaches that the technical agent (bonding agent) is coated on the inside or outer face of the sleeve (col. 1, lines 11-12, col. 1, line 66-col. 2, line 2, col. 3, lines

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27-30, 38-50 and 55-61 and col. 4, lines 26-41), and the urethane (col. 2, lines 55-61) corresponds to the claimed varnish.

In regard to claim 6, Inagaki teaches that the technical agent (bonding agent) is coated on the inside or outer face of the sleeve (col. 1, lines 11-12, col. 1, line 66-col. 2, line 2, col. 3, lines 27-30, 38-50 and 55-61 and col. 4, lines 26-41), and the urethane (col. 2, lines 55-61) corresponds to the claimed varnish.

In regard to claim 7, the urethane corresponds to the claimed thermosetting varnish as the technical agent (col. 2, lines 55-61).

In regard to claim 8, the urethane (item 4, Fig. 1 and 2) of Inagaki corresponds to the claimed thermosetting varnish (col. 2, lines 55-61). The varnish urethane (of Inagaki) is on a zone surrounding the embossed pattern (col. 2, lines 55-61 and Fig. 1 and 2).

In regard to claim 9, the urethane (item 4, Fig. 1 and 2) of Inagaki corresponds to the claimed thermosetting varnish (col. 2, lines 55-61). The varnish urethane (of Inagaki) is on the inside or outside face of the sleeve in the recesses formed by the embossed pattern (col. 2, lines 55-61 and Fig. 1 and 2).

In regard to claim 11, Inagaki teaches that the bonding agent has a fine screen (string pattern, item 9, Fig. 4) on its free face (col. 3, lines 7-11).

In regard to claim 12, the recitation "a screen is applied to the inside and/or outside face of the sleeve on at least some of the portions in relief formed by the embossed pattern" is a method limitation that has not been given patentable weight since the method of forming the wrapper is not germane to the issue of patentability of the wrapper itself. This recitation also

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does not describe the structure of the final product (the wrapper). There is no requirement in claim 12 that the screen is a component of the final product.

NEW OBJECTIONS

Specification

10. The amendment filed November 8, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The recitations of claims 11 and 12 that the “insert has a fine screen...” and “a screen is applied to [a] face of the sleeve”, respectively, are not supported in the specification as originally filed. See 35 U.S.C. 112, first paragraph, rejection of claims 11, 12 and 24 made of record below in this Office Action.

Applicant is required to cancel the new matter in the reply to this Office Action.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 11, 12 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitations of claims 11 and 12 that the “insert has a fine screen...” and

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“a screen is applied to [a] face of the sleeve”, respectively, are not supported in the specification as originally filed since none of the portions of the specification that discuss the screen disclose that the screen is actually a component of the wrapper. The portions of the specification that discuss the screen seem to discuss the screen as being used in the production of the wrapper and/or as a component of the apparatus used in the production of the wrapper. Claim 24 depends upon claim 11.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The structure that Applicant intends to recite by the recitation “a multiple-diffraction screen of lens type” cannot be ascertained. The scope of screens intended to be delineated by the recitation “of lens type” cannot be ascertained.

Claim Rejections - 35 USC § 102

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

16. Claims 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Inagaki (USPN 4,690,843).

In regard to claim 22, Inagaki teaches that the varnish (urethane) is a thermosetting polymer (col. 2, lines 55-61).

In regard to claim 23, Inagaki teaches that the varnish (urethane) is a thermoswelling polymer (col. 2, lines 55-61 and 30-38).

In regard to claim 24, Inagaki teaches that the bonding agent has a fine screen (string pattern, item 9, Fig. 4) on its free face (col. 3, lines 7-11). The structure of the screen that Applicant intends to recite by “a multiple-diffraction screen of lens type” cannot be ascertained, so this recitation cannot be treated other than citation to the teaching of Inagaki that the bonding agent has a fine screen on its free face (col. 3, lines 7-11 and Fig. 4).

In regard to claim 25, Inagaki teaches that the sleeve (base film, item 1, Fig. 1, col. 1, lines 3-4 and 55-56) has a single wall (base film, item 1, constitutes a single wall [Fig. 1] so it has a single wall.

Response to Arguments

17. Applicant's arguments presented on pages 6-7 of Amdt. A regarding the 35 U.S.C. 112 rejection of claims 2, 4, 10 and 11 have been fully considered but are not persuasive.

Applicant argues that “[s]emi-rigid” can be defined as “[p]artly or moderately rigid”. It is for the reason that it “can be” defined in the definition provided by Applicant that renders the claims indefinite: it “can be” defined that way, but not necessarily. It cannot be ascertained from the specification what Applicant intends to recite from the term “semi-rigid”. Applicant's specification does not define “semi-rigid” as “partly or moderately rigid”. Regardless, the adverbs “partly” and “moderately” themselves are relative terms that are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, so Applicant's reliance on a possible (“can be”) does not overcome the rejection of record. Applicant's citation to MPEP 2173.04, to a certain extent, implies that the term “semi-rigid” is specifically addressed in MPEP 2173.04, but it is not specifically addressed in MPEP 2173.04.

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Applicant's statement that "semi-rigid" would "delineate certain types of films to those ordinary skill in the art" is unsupported.

Applicant states that "Applicant is unsure what is unclear about 'coated in the technical agent'": the language used does not conform to how something would be described as being coated. A coating is coated onto something, that something is not referred to as being "coated in the" coating.

The response of the Office to Applicant's arguments for claims 2, 10 and 11 regarding "semi-rigid" also apply to Applicant's arguments for claims 10 and 11 regarding "rigid".

Applicant argues that "[r]igid" can be defined as "[n]ot flexible or pliant; stiff". It is for the reason that it "can be" defined in the definition provided by Applicant that renders the claims indefinite: it "can be" defined that way, but not necessarily. It cannot be ascertained from the specification what Applicant intends to recite from the term "rigid". Applicant's specification does not define "rigid" as "not flexible or pliant; stiff". The adjectives "flexible", "pliant" and "stiff" themselves are relative terms that are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It cannot be ascertained where the line is drawn between a material that would be considered semi-rigid and a material that would be considered rigid; this fact further contributes to the indefiniteness of claims 10 and 11.

18. Applicant's arguments presented on pages 7-8 of Amdt. A regarding the 35 U.S.C. 102 rejection of claims 1, 2 and 4-12 (and how Inagaki would be inapplicable to claim 25) have been fully considered but are not persuasive.

The recitation “said technical agent being positioned to ensure that said embossed pattern remains after said sleeve has been shrunk onto the article(s) to be packaged” has not been given patentable weight since this recitation does not describe the structure of the final product that is claimed (the wrapper). Applicant’s statement that the laminated structure of Inagaki “shows no pattern *before* shrinking”, taken in consideration with Applicant’s argument that Inagaki does not teach that the embossed pattern “*remains* after the sleeve has been shrunk onto an article”, is an admission that the final product comprises the embossed pattern. The structure of the final product is the only structure considered in an article claim, so Inagaki anticipates claim 1. There is no requirement that Inagaki teach that “an embossed pattern is present *before* heat shrinking” since the structure of the final product is the only structure considered in an article claim.

In regard to claim 25, Inagaki teaches that the sleeve (base film, item 1, Fig. 1, col. 1, lines 3-4 and 55-56) has a single wall (base film, item 1, constitutes a single wall [Fig. 1] so it has a single wall.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Walter B. Aughenbaugh
01/18/07

WBA



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1/19/07